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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/580,798

05/26/2006

Yoshitsugu Morita

71,051-032

6458

27305

7590

11/20/2009

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EXAMINER

FLETCHER III, WILLIAM P

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

11/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,798	Applicant(s) MORITA ET AL.	
	Examiner William P. Fletcher III	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/29/2007 & 7/24/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of claims 1 and 3-9 in the reply filed on November 6, 2009, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Response to Amendment

2. Claims 1 and 3-9 remain pending.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

4. The information disclosure statements filed May 29, 2007, and July 24, 2007, have been considered.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 3-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Meguriya et al. (US 4,714,265 A).

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7. This reference teaches a method of manufacturing a layered silicone composite material in which a first composition is applied to the surfaces of a mold, the first composition is cured, a second composition is applied to the cured first composition, and the second composition is cured. One of the compositions is a hydrosilation-curable (i.e., addition-curable) silicone (i.e., organopolysiloxane) rubber composition (A) and the other is an addition-curable silicone-epoxy composition (B) [2:49-57]. Composition (A) yields a layer having a JIS A hardness greater than 95 and composition (B) yields a layer having a JIS A hardness of 35 [15:20-23]. Compositions (A) and (B) may be applied in either order [2:49-57 and 13:48-14:1]. Where composition (B) is applied first, followed by composition (A), the resultant structure anticipates the claimed structure where the first silicone layer has a hardness of less than JIS A 50 and the second silicone layer has a hardness of greater than or equal to JIS A 50.

8. While this reference does not expressly refer to any of the components of the compositions (A) and (B) as adhesion promoters, it is disclosed that the layers formed from these two compositions are firmly bonded together [abstract]. It is the Examiner's position that the ability of one layer to bond to the other is a physical property of the layer. Since Applicant has not expressly limited the term "adhesion promoter" in the disclosure, it is the Examiner's position that any component making up one of the layers may be considered as contributing to the physical bonding properties of the layer and may properly be considered an adhesion promoter, absent evidence to the contrary. Consequently, the limitations *containing a first adhesion promoter* and *containing a second adhesion promoter* and anticipated.

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9. The hydrosilation-curable silicone rubber composition (A) contains an organopolysiloxane $R^1_bSiO_{(4-b)/2}$, where R^1 may be an alkenyl group [4:38-5:15] and an organohydrogenpolysiloxane $R^2_cH_dSiO_{(4-c-d)/2}$, where at least two or three H atoms are bonded to the Si atoms [5:16+]. Since, as noted above, any component of the composition (A) may anticipate the claimed adhesion promoter, the limitations of claim 4 requiring that one of the adhesion promoters contain *at least one silicon-bonded alkenyl group, at least one silicon-bonded hydrogen atom, or both*, are anticipated.

10. The addition-curable silicone-epoxy composition (B) contains, in addition to an epoxy group [6:44], an organopolysiloxane having an average of at least two alkenyl groups [6:45-47], an organohydrogenpolysiloxane having at least one H atom bonded to the Si atom in the molecule [6:49-50] and a group R^4 which may include trialkoxy silyl groups such as 3-trimethoxysilylpropyl and 3-triethoxysilylpropyl groups, as well as additional epoxy groups [8:26-48]. Since, as noted above, any component of the composition (B) may anticipate the claimed adhesion promoter, the limitations of claims 3-5 and 9 requiring: that one of the adhesion promoters be *an organosilicon compound containing, per molecule, at least one alkoxy group*; that one of the adhesion promoters contain *at least one silicon-bonded alkenyl group, at least one silicon-bonded hydrogen atom, or both*; that one of the adhesion promoters contain *at least one epoxy group*.

11. The presence of filler is disclosed as optional [4:22-37; 6:21-35; and 13:39-47], thereby anticipating the limitations of claim 6 requiring that one of the composition be *free of inorganic filler*.

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12. Finally, with respect to claim 7 and 8, it is the Examiner's position that the compositions (A) and (B), in the absence of the optional opacifying pigments and fillers, if not transparent, are at least translucent, permitting the passage of light. US 5,585,445 A is cited solely as evidence that a composition identical or very similar to that applied in Meguriya is transparent. As such, since Applicant has not expressly limited the terms "optically transparent" or "optical element," it is the Examiner's position that the inherent property of the article of Meguriya to permit passage of light anticipates the claim limitations requiring that the silicon composite be *optically transparent* and *at least part of an optical element*.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. JP 05-069511 A and JP 05-069512 A, cited by Applicant, disclosed methods for manufacturing silicone composites, but require simultaneous curing of the two layers and do not read on the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Sunday, 5:00 AM - 12:00 PM and Monday through Friday, 5:00 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William Phillip Fletcher III/
Primary Examiner, Art Unit 1792

November 18, 2009